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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,622	10/31/2001	Jonathan K. Riek	83630DMW	4926

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EXAMINER

FOULADI SEMNANI, FARANAK

ART UNIT	PAPER NUMBER
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2672

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/998,622

Applicant(s)

RIEK ET AL.

Examiner

Faranak Fouladi

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is responsive to communications: Application filed on 10/31/2001.
2. Claims 1-24 are pending in the case, with claims 1, 11 and 18 being independent.
3. The present title of the application is "Method and apparatus for generating image transitions" (as originally filed).

**Specification**

4. The disclosure is objected to because of the following informalities: There is a grammatical error in the last paragraph of Summary Of The Invention starting from the middle of line 31 on page 2 through line 2 of page3. It reads *"The use of B pictures only to provide the transitions allows a transition to be inserted in the MPEG sequence in the same manner for any sequence, regardless of the sequence content."*  
  
Appropriate correction is required.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 recites the limitation "the sequence" in part (b) of the claim on page 14. There is insufficient antecedent basis for this limitation in the claim.

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- ✓ 6. Claim 2 recites the limitation "the pictures" in line 1 of the claim on page 14.

There is insufficient antecedent basis for this limitation in the claim.

7. Claims 10, 17, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 10 provide for the use of "the method of claim 1", claim 17 provide for the use of "the method of claim 11", and claim 24 provide for the use of "the method of claim 18" but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

9. Claims 10, 17, and 24 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Jun et al. in Proceedings of the eighth ACM international conference on Multimedia published October 2000, hereafter Jun.

10. Regarding Independent claim 1, "a method for encoding a transition in an MPEG bitstream sequence including anchor pictures and bidirectionally predicted (B) pictures, said method comprising the steps of:
  - a) coding first and second anchor pictures; and
  - b) coding a transition in the sequence by inserting B pictures into the bitstream to create the transition from the first anchor picture to the second anchor picture." Jun teaches in section 3 on page 392 and Figure. 1.
11. Regarding dependent claim 2,"the method as claimed in claim 1 wherein the pictures are comprised of macroblocks and wherein the insertion of the B

pictures into the bitstream to create the transition from the first anchor picture to the second anchor picture comprises starting with a B picture in which most of the macroblocks are predicted from the first anchor picture and ending with a B picture in which most of the macroblocks are predicted from the second anchor picture." Jun teaches in section 3.1 on page 392.

12. Regarding dependent claim 3, "the method as claimed in claim 1 wherein the pictures are comprised of macroblocks and wherein the insertion of the B pictures into the bitstream to create the transition from the first anchor picture to the second anchor picture comprises switching a number of macroblocks in each of the B pictures from being forward predicted to being backward predicted." Jun teaches in section 3.1 on page 393 (left column).
13. Regarding dependent claim 4, "the method as claimed in claim 3 wherein the insertion of the B pictures into the bitstream to create the transition from the first anchor picture to the second anchor picture comprises randomly switching a predetermined number of macroblocks in each of the B pictures from being forward predicted to being backward predicted." Jun teaches in section 3.1 on right column, second paragraph of page 392 through 3.2 on page 393 (left and right columns).

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14. Regarding dependent claim 5, "the method claimed in claim 1, where the first and second anchor pictures in step a) correspond to a last anchor picture in a first video sequence and a first anchor picture in a second video sequence." Jun teaches in last paragraph of section 3.1 on page 393.
15. Regarding dependent claim 6, "the method claimed in claim 5, where the video sequences comprise a group of still images." Jun teaches in section 4 line 1 in first paragraph on page 393.
16. Regarding dependent claim 7, "the method claimed in claim 1, where the B pictures in step b) comprise macroblocks that are forward predicted, backward predicted, or interpolated." Jun teaches in section 3.1 in last paragraph, right column, page 392.
17. Regarding dependent claim 8, "the method claimed in claim 7, where none of the macroblocks contain DCT coefficients." Jun teaches in section 3.1 in last paragraph, right column, page 392.
18. Regarding dependent claim 9, "the method claimed in claim 7, where each of the macroblocks contain motion vectors that are (0,0)." Jun teaches in section 3.1 in last paragraph, right column, page 392.

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19. Regarding dependent claim 10, "a computer storage medium having instructions stored therein for causing a computer to perform the method of claim 1." It is inherent to have a computer readable media to store or transport computer readable code in a computer system. For example compact disc has been included and used in the computer systems since 1990s or magnetic data storage devices have been used since 1980s.
20. Claims 11-24 also recite a method for encoding a transition in an MPEG bitstream sequence similar in scope to claims 1-10 therefore are rejected under the same rationale.

***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 form.
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faranak Fouladi whose telephone number is 703-305-3223. The examiner can normally be reached on Mon-Fri from 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reach at 703-305-4713.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC. 20231

Or faxed to: 703-872-9314 (for Technology Center 2600 only)

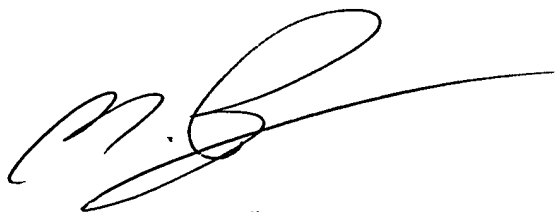
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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, sixth-floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is 703-872-9306.

Faranak Fouladi-Semnani  
Patent Examiner  
Art Unit 2672



MICHAEL RAZAVI  
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